

Remarks

The Office action mailed May 13, 2003, has been reviewed and carefully considered. The applicants' attorney thanks Examiner Kifle for the courtesy extended during a telephone conference interview on July 29, 2003. Claims 29-38 and 43-45 were discussed during the interview, especially independent claims 29 and 30. The Garofalo et al. article cited by the examiner was discussed as it relates to claims 29 and 30. The arguments regarding the 35 U.S.C. §102(b) rejection presented to the examiner are detailed below. The 35 U.S.C. §112 rejections were not discussed during the interview. Applicants note that the Interview Summary PTO-413 inadvertently indicates that the R₅ substituent is the basis for distinguishing over the prior art. However, the R₅ substituent was not discussed during the interview. Rather, other substituent groups were discussed as explained below.

Claims 1-28 and 39-42 have been canceled as being drawn to a non-elected invention without prejudice for filing a divisional application. Claims 43-45 have been canceled. Claim 29 has been amended to correct a typographical error. New claims 46-61 have been added. Claims 46-61 are method of use claims that track the compound claims. It is respectfully submitted that the pending rejections should be reconsidered and withdrawn.

Election/Restriction Requirement

Applicants reiterate that compound 19 in Table 1 on page 26 of the application was elected in response to the election of species requirement. However, Examiner Kifle expanded the search "to embrace compounds of Table 1 (compounds 1-31) along with compounds wherein ring A represents o-1,2-phenylene and o-1,2-naphthalene; W represents S and the full scope of the remaining variables, and their pharmaceutical composition" (see page 2 of the Office action). Claims 30-36 and 38 should be rejoined since these claims read on elected compound 19 and they are allowable as explained below. New claims 46-61 are method of use claims involving the compounds recited in claims 28-36. Added claims 46-61 are readable on the elected species, and thus these claims should be considered since the compound claims are allowable as explained below. Hence, original claims 29-38 and new claims 46-61 remain present in the application.

35 U.S.C. §112 Rejections

Claims 29-38 have been rejected under 35 U.S.C. §112, second paragraph, for alleged indefiniteness. In claim 29, R₅ may be an “alkylamine.” Independent claim 30, unlike claim 29, does not include the term “alkylamine.” It is readily understood in the art that an alkylamine is a substituent that includes any combination of alkyl and amine groups. For example, an alkylamine may be a primary amine (e.g., -alkyl-NH₂), a secondary amine (e.g., -NH-alkyl), or a tertiary amine (e.g., -N(alkyl)₂).

Claim 29 also includes the phrase “substituted or unsubstituted alkyl or amine”. Independent claim 30, unlike claim 29, does not include this phrase. Page 10, lines 22-26, lists illustrative substituent groups.

It is clear that a skilled artisan would have no difficulty ascertaining the meaning of the terms in claim 29 that have been questioned by the examiner. In addition, these terms do not even appear in independent claim 30. Accordingly, the pending 35 U.S.C. §112, second paragraph, rejection cannot stand.

35 U.S.C. §102 Rejections

Claims 29 and 37 have been rejected under 35 U.S.C. §102(b) over compounds 15-19 of Garofalo et al. Claims 29 and 37 recite a compound wherein “R is one or more of halogen or NO₂” in each of the structures shown in the claims. None of the compounds 15-19 of Garofalo et al. include such a halogen or NO₂ substituent. Accordingly, the 35 U.S.C. §102(b) rejection must be withdrawn. Applicants also note that a 35 U.S.C. §103 rejection over Garofalo et al. would be inappropriate since Garofalo et al. does not suggest a halogen or NO₂ substituent.

Claims 30-36 and 38 were withdrawn due to the allegedly anticipatory disclosure in Garofalo et al. However, as pointed out above, Garofalo et al. does not anticipate claims 29 and 37, and thus claims 30-36 and 38 must be rejoined.

Upon inspection, it is apparent that Garofalo et al. also does not anticipate the subject matter of claims 30-36 and 38. Claim 30 recites four generic structures. With respect to the first and third structures, claim 30 states that “R₁ and R₂ are not both H or not both alkoxy.” In

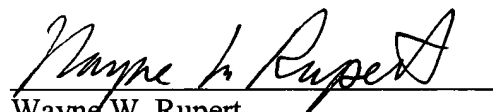
compounds 15-19 of Garofalo et al. the R substituents are both either H or alkoxy. The second structure of claim 30 includes a naphthalene ring fused to the W-containing ring. Compounds 15-19 of Garofalo et al. do not include such a naphthalene ring. The fourth structure of claim 30 includes an R₆ substituent. Compounds 15-19 of Garofalo et al. do not include such a similarly positioned substituent. A 35 U.S.C. §102(b) rejection of claims 30-36 and 38 over Garofalo et al. would be inappropriate since this reference fails to disclose any of the four generic structures depicted in claim 30. Similarly, a 35 U.S.C. §103 rejection of claims 30-36 and 38 would also be inappropriate since Garofalo et al. does not suggest any of the claimed structures.

It is submitted that the present claims are in condition for allowance. Should there be any questions regarding this application, Examiner Kifle is invited to contact the undersigned attorney at the telephone number shown below.

Respectfully submitted,

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